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Eric T Jones
Reising Ethington Barnes Kisselle Learman &
McCulloch
P O Box 4390
Troy, MI 48099-4390

EXAMINER

GEHMAN, BRYON P

ART UNIT	PAPER NUMBER
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3728

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06/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/523,757

Applicant(s)

SMYTH, IAIN

Examiner

Bryon P. Gehman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-26 and 28-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-26 and 28-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person **to be material to patentability as defined in 37 CFR 1.56**.

2. The disclosure is objected to because of the following informalities:

On page 5, the second last line, "and" should be --an--.

On page 6, "pocketed region 24" in line 22 and "pocket 24" are inconsistent terminology.

On page 7, lines 8-15, two hinges are given various names inconsistently through the passage, rendering understanding difficult. In line 19, "figure" should be capitalized to be consistent with previous definition. In lines 25-28, the term "carrier" by itself should apparently be --carriage--.

On page 8, lines 4-6, "figure(s)" should be capitalized. In line 9, the propriety of "immediate" is questioned.

On page 9, lines 1, 4 and 5, "figure(s)" should again be capitalized. In lines 9-16, "panel" and "panel region" are used interchangeably, which is improper as "panel" by itself is a noun while in conjunction with "region" it is an adjective, and a panel is not seen to be the same in scope as a panel region. In lines 17 and 18, "carrier portion 14"

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and "carriage portion 14" are inconsistent with each other and previous terminology referring to element 14.

Applicant should review the specification for other errors, in view of the great number already found.

Appropriate correction is required.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The terminology of claim 25, i.e. "first, second and third elements" and "first and second protective regions" re not described in the specification nor remains unapparent from the structure as disclosed to render the claimed structure correlating to the claimed structure.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The incongruity of the language of claim 25 with

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respect to the disclosed structure as described in the specification renders the claim indefinite. In addition, the carrier has been amended to claim three hinges, three hinges not being referenced with respect to any of the disclosed embodiments as now claimed.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 19-26 and 28-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 19, line 11, "axially offset" is indefinite, as no axis has been defined or is apparent from the claimed blank.

In claim 20, line 2, "further, flap" should not include the comma, as it interrupts the claimed structure and renders it indefinite.

In claim 24, lines 2 and 4, "the further flap" lacks antecedent basis from parent claim 19.

In claim 25, the general language of the entire claim has no correlation to that of the specification and such renders the scope and meaning of the claim indefinite in light of the specification. In line 5, "the first hinge" lacks antecedent basis, as "a hinge region" is not clearly antecedent for a "first hinge" nor is a "region" of three elements distinguish a single "hinge".

In claim 26, line 11, "another portion" is indefinite and should probably be --another position--.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 19, 26, 28-30 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Sherman (6,505,737) (Figures 6A-E). Claims 19, 26, 28-30 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Feigelman (2,706,037) (Figure 2). As to claim 19, each discloses a blank (see Figure 6A and the attached sheet for element designations; see Figure 2) comprising a first panel (see attached sheet; 20a) connected to a second panel (see attached sheet; either upper 21), a third panel (see attached sheet; either upper 22) connected to the second panel so that the third panel can be folded over the second panel to form a protected region, a carriage panel (see attached sheet; either lower 21) connected to a pocket panel (see attached sheet; either lower 22) so that the pocket panel can be folded over the carriage panel to form a pocket, and an intermediate panel (see attached sheet; 20b) connected to the carriage panel, and the intermediate panel joins the first panel along a boundary (see attached sheet; 38) at right angles to the connection between the first and second panels; and

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the intermediate panel attaches to the carriage panel along a boundary (see attached sheet; either lower 28) that is parallel to and offset from the connection (see attached sheet; opposite other upper 28) between the first and second panels.

As to claim 26, disclosed is a case for an object, the case comprising a first portion (B') hingeably attached to a second portion (E'), and a carriage (U') for holding the object, the carriage movable in response to the movement of the first portion with respect to the second portion between a first position (described collapsed position) where the object is in a protected space and a second position (described display position) where the object is presented for removal from the case, and the carriage is hingeably attached to the first portion by a hinge (at conjunction of U' and B') connecting the first and second portions, the case further comprising a third portion (Z') hingeably attached to the first portion, and a second carriage (P) for holding a further object, the second carriage being movable in response to movement of the second portion with respect to the third portion between a position (P (or 48) folded over 10' in Figure 6E) where the further object is held in a further protected space and another position (Figure 6E) where the further object is presented for removal from the case, and the second carriage is hingeably attached to the second portion

As to claim 28, at least one of the first and second portions is formed with a wall or spacing element (between 24' and U') to give the case depth.

As to claim 29, a holding device (30') appears to provide the described function.

As to claim 30, a pocket (63) for additional articles is disclosed.

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10. Claims 23 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Feigelman. Disclosed is a method of forming a case from a blank comprising a first panel (20a) connected to a second panel (upper 21), a third panel (upper 22) connected to the second panel so that the third panel can be folded over the second panel to form a protected region (between 21 and 22 in Figure 1), a carriage panel (lower 21) connected to a pocket panel (lower 22) so that the pocket panel can be folded over the carriage panel to form a pocket (between 21 and 22 in Figure 1), and an intermediate panel (20b) connected to the carriage panel and wherein the intermediate panel joins the first panel along a boundary (38) at right angles to the connection between the first and second panels, the method comprising folding the intermediate panel so that it overlies the first panel (see Figure 1) and the carriage panel overlies the second panel (see Figure 1), and folding the pocket panel and third panel over so that the carriage panel is within a protected region (see Figure 1).

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 20-22, 24 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Sherman ('737) and Feigelman in view of Kleinfelder (5,647,482). Kleinfelder discloses a blank for manufacturing a case, the blank including

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additional flaps (6, 7 or 22) that serve to secure the content within the manufactured case or secure the panels of the case to one another. To modify the blank of either one of Sherman or Feigelman employing additional flaps in the manner suggested by Kleinfelder would have been obvious in order to close off the ends of the panels or engage contents of the panels, as suggested by Kleinfelder.

13. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sherman ('737) in view of Wharton (6,557,700). Wharton discloses employing a case for either CDs or pharmaceutical products interchangeably. To employ the CD case of Sherman for appropriately shaped pharmaceutical products would have been obvious in view of the teaching of Wharton.

14. Applicant's arguments with respect to pending claims have been considered but are moot in view of the new grounds of rejection. Claim 25 remains unable correlate to the disclosed structure. The description of three hinges does not appear to be described as such in the specification. Some of this is due to the various embodiments now being considered. I

15. This action is made non-final in view of the new grounds of rejection.

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16. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

I) Figures 1-5b, 9 and 11-12; II) Figure 6; III) Figure 7; IV) Figure 8; V) Figures 10a-10c and VI) Figure 13.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

17. The claims are deemed to correspond to the species listed above in the following manner:

Species I, claims 19-24, 26 and 28-35; Species II, claims 26 and 28-33; Species III, claims 26 and 28-33; Species IV, claims 26 and 28-33; Species V) claims 26 and 28-33; and Species VI) claims 26 and 28-33. Claim 25 is indefinite and presently indeterminate which species it pertains to. It is not seen from the Figures that the boundary is "offset" in Species II-VI, since the blank is not represented in the Figures of those species to enable an offset relationship.

The following claim(s) are generic: 26, 28-30 and 33.

18. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: At present, it is not seen that a single special technical feature common to all species is patentable over the prior art.

19. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571)

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272-4555. The examiner can normally be reached on Monday through Wednesday from 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bryon P. Gehman/
Primary Examiner
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BPG